

This Opinion is Not a
Precedent of the TTAB

Hearing: February 24, 2021

Mailed: March 9, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re The Pennsylvania State University
—

Serial Nos. 88311154 and 88311234
—

Lucy J. Wheatley, Claire H. Eller, Amanda L. DeFord of McGuireWoods LLP,
for The Pennsylvania State University.

Sarah E. Kunkleman, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

—
Before Wolfson, Goodman, and English,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

The Pennsylvania State University (“Applicant”) seeks registration on the
Principal Register of the standard character mark PENNSTATE HEALTH and the

mark  **PennState Health**

(“Health” disclaimed in both marks) for:

“Educational services, namely, providing courses of instruction at the university and graduate level in the field of health care; Medical training and teaching; Providing fitness and exercise facilities; Research in the field of patient education” in International Class 41;

“Medical and scientific research and development; providing medical and scientific research information in the field of health, healthcare, disease, medicine; Medical and scientific research, namely, conducting clinical trials for others; Medical laboratories” in International Class 42;

“Health care; blood bank; Charitable services, namely, providing medical services, medical equipment, and medical supplies; Charitable services, namely, patient assistance programs to provide drugs and medical care free of charge to low-income patients; hospital services; emergency medical services; Medical clinic services; Pediatric health care services; Surgery; Medical evaluation, diagnosis and treatment of allergic rhinitis, asthma, food allergy, venom allergy, bone and joint conditions, cancer, brain injuries, skin conditions, heart conditions, eating disorders, immune disorders, behavioral disorders, diabetes, hormone disorders; Behavioral health services; Medical services; Hospice services; Consulting services in the fields of medical, dental, optical, pharmaceutical, wellness and nursing care; Nursing care; Optician and optometry services; Counseling in the fields of mental health, nutrition and wellness; Dispensing of pharmaceuticals; Providing health and medical information; Rental of medical equipment; Home health care services; Providing wellness services, namely, personal assessments, personalized routines, maintenance schedules, and counseling” in International Class 44; and

“Grief and bereavement counseling; Licensing of intellectual property; Ministerial services; Providing personal support services for families of patients, namely, companionship, help with medical forms, emotional counseling and emotional support” in International Class 45.¹

¹ Application Serial No. 88311154 for the standard character mark was filed on February 21, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s allegation of first use and first use in commerce of July 1, 2015 in all classes. Application Serial No. 88311234 for the composite mark was filed on February 21, 2019, on the basis of Applicant’s allegation of first use and use in commerce of July 1, 2015 in all classes. The description of the mark reads: “The mark consists of design of a lion head inside a shield on a contrasting background with the words ‘PENNSTATE HEALTH’ to the right of the shield.” Color is not claimed as a feature of the mark and the stippling is for shading purposes only.

The Trademark Examining Attorney refused registration of Applicant's marks under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the ground that the phrase "PENNSTATE HEALTH" is primarily geographically descriptive of the services identified in the applications. The standard character mark is refused in its entirety, and the composite mark is refused absent a disclaimer of the wording "PENNSTATE HEALTH." Section 6 of the Trademark Act, 15 U.S.C. § 1056. Applicant argues that "the Examining Attorney has simply failed to carry her burden of showing that PENN STATE is generally known as a nickname for the Commonwealth of Pennsylvania[.]" 8 TTABVUE 17.²

When the refusals were made final, Applicant appealed and requested reconsideration, which was denied. The Board consolidated the cases on Applicant's motion. 10 TTABVUE. An oral hearing was held February 24, 2021.

I. Applicable Law

Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), prohibits the registration on the Principal Register of a mark that "when used on or in connection with the goods of the applicant is primarily geographically descriptive of them," unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f). To refuse registration of a mark on the ground that it is primarily

² All citations in this opinion to the appeal record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Citations to the prosecution history of the applications are to pages from the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO") in Serial No. 88311154, unless otherwise noted.

Serial Nos. 88311154 and 88311234

geographically descriptive of the goods or services identified in an application, the USPTO must establish that:

1. the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public;
2. the source of the goods or services is the place named in the mark; and
3. the public would make an association between the goods or services and the place named in the mark by believing that the goods or services originate in that place.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448 (Fed. Cir. 2015); *see also In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014).

A geographic nickname (e.g., “Big Apple” or “Motown”), or an abbreviation or other variant of the name of a geographic location, is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public. *See In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007) (holding that “Yosemite” is a well-recognized and frequently used shorthand reference to Yosemite National Park); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA as indicator of either North or South Carolina is geographically descriptive); *In re Jack’s Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) (NEOPOLITAN is primarily a geographic term naming the city of Naples, Italy); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238 (TTAB 1975) (OLD DOMINION recognized as nickname for State of Virginia).

II. The Record

The Examining Attorney submitted the evidence listed below to prove that “Penn” is an abbreviation for “Pennsylvania”:³

1. Definitions of “Penn” (without a final period) from Acronymfinder.com (June 4, 2019 Office Action, TSDR 2);
2. Definitions of “Penn” from Merriam-Webster.com. (June 4, 2019 Office Action, TSDR 3-5); and
3. Definitions of “Penn.” (with a final period) from the American Heritage and Macmillan dictionaries (August 13, 2020 Denial of Request for Reconsideration at TSDR 5, 7).⁴

The Examining Attorney also submitted copies of website pages from third parties using PENN or PENNSYLVANIA:

1. Website for “PENNSYLVANIA’S STATE SYSTEM OF HIGHER EDUCATION” (August 13, 2020 Denial of Applicant’s Request for Reconsideration, TSDR 20);
2. Pennsylvania Department of Human Services website providing a list of “Pennsylvania State Hospitals Contact” under the category of “PA State Hospitals” (*Id.* at 21-23); and
3. PENN STATE CONSTRUCTION website promoting general construction services and “ACM panels” manufactured in

³ The meaning of the term “STATE” as “one of the constituent units of a nation having a federal government,” that is, as one of the fifty states of the United States, is not in dispute. See MERRIAM-WEBSTER online dictionary, at <https://www.merriam-webster.com/dictionary/state>, attached to August 13, 2020 Office Action at TSDR 11.

⁴ We note Applicant’s request that we take judicial notice that: “Cambridge’s online dictionary (dictionary.cambridge.com), Dictionary.com, and thefreedictionary.com—show that ‘Pennsylvania’ is not included among the recognized definitions of PENN.” Reply Brief, 12 TTABVUE 7. Although “the Board may take judicial notice of dictionary definitions at any time,” *In re White*, 73 USPQ2d 1713, 1716 (TTAB 2004), including when presented in an applicant’s reply brief, we decline to do so here, because Applicant has not provided copies of the pages on which such “non-entries” would otherwise have been found.

Lewistown, PA by “Penn State Construction J&D, LLC,” located in Lewistown, PA. (*Id.* at 27-28).⁵

Applicant counters this evidence by submitting excerpts from Internet searches for the term “pennstate.” Results were returned for PENN STATE, but not PENNSTATE. *See* November 22, 2019 Response to Office Action, TSDR 2-9. All but three of the 17 excerpts for PENN STATE use the term to refer to Applicant.⁶ Applicant also submitted six articles giving various nicknames for Pennsylvania, such as “The Keystone State,” “The Quaker State,” “The Oil State,” “The Coal State,” “The Steel State,” and “PA” (pronounced pee-ayy). None mention PENN as a possible abbreviation. June 12, 2020 Request for Reconsideration, TSDR 2-53.

Both the Examining Attorney and Applicant further rely on USPTO records to support their positions. The Examining Attorney submitted copies of prior registrations owned by Applicant, where “PENN STATE” was disclaimed or subject to a claim under Trademark Act Section 2(f). The registrations are:

1. Reg. No. 5766698 for the mark PENN STATE for various goods (claim under § 2(f) as to the entire mark);

⁵ The Examining Attorney also submitted a reference for Penn State Industries, a pen manufacturer. August 13, 2020 Denial of Applicant’s Request for Reconsideration, TSDR 24-26. The use of the term “Penn” in this instance is likely as a family surname, and also may have been an intentional word-play on the word “pen.” Therefore, it has little bearing on the overall impression of the search results as pointing to Applicant, and the Examining Attorney did not pursue this reference in her brief.

⁶ Two of the three references that do not refer to Applicant are for “Strayer University” and “American Military University.” Neither reference mentions PENN, PENN STATE or PENNSTATE and are therefore irrelevant. The third reference is for “Penn State Industries,” the pen manufacturer. November 22, 2019 Response to Office Action, TSDR 5.

2. Reg. No. 5854383 for the mark  PENN STATE NITTANY LIONS and design for various goods (claim under § 2(f) as to “PENN STATE”);
3. Reg. No. 5441650 for the mark PENN STATE for “pretzels” (claim under § 2(f) as to the entire mark);
4. Reg. No. 4561709 for the mark PENN STATE WHITE OUT for services in International Class 35 (claim under § 2(f) as to “PENN STATE”);
5. Reg. No. 5052191 for the mark PENN STATE WHITE OUT for “shirts” (claim under § 2(f) as to the entire mark);
6. Reg. No. 4439041 for the mark PENN STATE for “candy” (claim under § 2(f) as to the entire mark);
7. Reg. No. 3786583 for the mark PENN STATE FEDERAL CREDIT UNION and design for credit unions (disclaimer of all words);
8. Reg. No. 1308610 for the mark PENN STATE for various goods and for services in International Classes 41 and 42 (claim under § 2(f) as to Classes 41 and 42 only) and
9. Reg. No. 1289373 for the mark PENN STATE ALUMNI ASSOCIATION for indicating membership and for arranging tours and cruises (disclaimer of “ALUMNI ASSOCIATION” and claim under § 2(f) as to the entire mark).

Applicant submitted three other registrations it owns, for marks comprising PENNSTATE as one word, where there was no disclaimer or showing of acquired distinctiveness required of “PENNSTATE.” November 22, 2019 Response to Office Action, TSDR 10-15. These registrations are:

1. Reg. No. 1870005 for  for “medical transportation services by helicopter” in International Class 39. (Disclaimer of “1855”).



2. Reg. No. 1732445 for  for various merchandising goods and services including “emergency medical transportation services and assisting in arranging for travel for others” in International Class 39. (Disclaimer of “1855”).



3. Reg. No. 5393863 for  for educational (including in the health and medical field) and entertainment services, athletic instruction and coaching in International Class 41. Issued February 6, 2018.

The Examining Attorney also submitted a printout of pending application Serial No. 88311220 for the standard character mark PENN STATE HEALTH, owned by Applicant and published for issuance on September 15, 2020. August 13, 2020 Denial of Applicant’s Request for Reconsideration, TSDR 2-4. The services are the same as those in Applicant’s applications that are the subject of this appeal. The Examining Attorney argues in her brief that the mark registered on December 1, 2020, under Reg. No. 6208399 with a disclaimer to “HEALTH” and a Section 2(f) statement. 11 TTABVUE 9-10.

The registration is not of record. The Examining Attorney did not request a remand to properly make this registration of record, and we do not take judicial notice of registrations residing in the Office.⁷ *In re MK Diamond Prods.*, 2020 USPQ2d

⁷ The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a timely written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.02 and authorities cited therein. The request must include a showing of good

10882, *1 n.5 (TTAB 2020) (“The Board does not take judicial notice of registrations in Office records.”) (citing *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1644 (TTAB 2011) (refusing to take notice of registration acquired by applicant after appeal was instituted)). *Cf. WeaponX Perf. Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018) (finding plaintiff’s pleaded application not automatically of record, and must be introduced as evidence at trial); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (“[W]e do not take judicial notice of application and registration files that reside in the Patent and Trademark Office on the basis of their mere identification in briefs, pleadings and evidentiary submissions.”).⁸

III. Analysis

It is undisputed that Applicant is located within the Commonwealth of Pennsylvania and renders its services in Pennsylvania.⁹ *See, e.g.*, Applicant’s website from June 4, 2019 Office Action, TSDR 19 (“Penn State Health Milton S. Hershey Medical Center offers a wide range of health care services at hospitals and outpatient

cause, which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal.

⁸ Even if the registration were of record, it would not change the result in this case. Evidence substantially similar to that in the registration is present in the other of Applicant’s registrations properly submitted by the Examining Attorney.

⁹ The Examining Attorney does not dispute that Pennsylvania is technically a Commonwealth, but presented evidence showing that it is also commonly referred to as a state. *See* June 4, 2019 Office Action, TSDR 6 (Merriam-Webster online definition of “Pennsylvania” as “state in the northeastern U.S.”); August 13, 2020 Reconsideration Letter, TSDR 23 (web page from the Pennsylvania Department of Human services, displaying official government seal with the wording “SEAL OF THE STATE OF PENNSYLVANIA”). Accordingly, we accept that the public’s perception of Pennsylvania includes as a “state.”

practice sites across central Pennsylvania”); excerpt of Internet search from November 22, 2019 Response to Office Action, TSDR 6 (“The Pennsylvania State University is a state-related, land-grant, doctoral university with campuses and facilities throughout Pennsylvania.”).

Accordingly, there is no real issue that a services-place association would be made by the public if the mark, as a whole, projects a geographical significance. *See Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014) (services-place association can be presumed when the services do in fact emanate from the place named in the mark); *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (“[W]here there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named by the term is neither obscure nor remote, a public association of the goods or services with the place may ordinarily be presumed from the fact that the applicant’s goods or services come from the geographical place named in the mark.”).

The principal point of contention concerns the first prong of the geographic descriptiveness test: whether the primary significance of the term PENNSTATE connotes “a place known generally to the relevant American public.” *Newbridge Cutlery*, 113 USPQ2d at 1450.¹⁰ The relevant public “is the purchasing public in the United States of [the] types of goods [or services]” identified in the involved

¹⁰ Applicant does not dispute that “health” is descriptive of Applicant’s services and has disclaimed the term HEALTH in each mark. Therefore, the presence of “HEALTH” in each mark is a lesser factor as to whether the mark is considered a geographic term or a source indicator; rather, the term PENNSTATE in each mark is determinative of the issue.

application. *Id.* at 1449. The average consumer of Applicant's services is a person seeking diagnostic, medical or surgical services as well as ministerial, counseling and other personal support services.

The Examining Attorney contends that PENNSTATE and PENN STATE are legally equivalent; and that inasmuch as PENN is a common abbreviation for PENNSYLVANIA, and STATE describes one of the fifty states of the United States, "by definition the combination of the words, 'PENN' and 'STATE' describes a geographic location." 11 TTABVUE 8. Applicant argues that the "primary significance of PENNSTATE in the minds of potential purchasers is unquestionably as the well-known nickname for the applicant Penn State." 8 TTABVUE 21.

We agree with Applicant that the unitary term "PENNSTATE" is not a generally known geographic location. The dictionary and acronym definitions for "Penn" and Penn." are inconclusive, referring equally to Pennsylvania, Admiral Penn and his son, and the University of Pennsylvania. The acronymfinder.com listing gave a five-star ranking to both "PENN" as an abbreviation for "Pennsylvania" and as an abbreviation for the "University of Pennsylvania." The Merriam-Webster entry contains three entries for "Penn" - not only as an abbreviation for "Pennsylvania," but also as the biographical name of William Penn, the "English Quaker and founder of Pennsylvania" and of his father, Sir William Penn, an "English admiral." Finally, the American Heritage and Macmillan results showing that "Penn." (with a period) is an abbreviation for "Pennsylvania" may be considered probative to suggest that "Penn" (without a period) is more likely to project the alternative meaning as a surname.

The Examining Attorney argues that Applicant conceded that PENN STATE is primarily geographically descriptive by having “claimed acquired distinctiveness under Trademark Act Section 2(f) unconditionally and not in the alternative for PENN STATE in amendments subsequent to the initial application [in Applicant’s prior registrations].” 11 TTABVUE 10. We disagree. Any concession made with respect to “Penn State” in other registrations does not automatically carry over to the present applications, particularly in light of the differing treatment accorded Applicant’s three PENNSTATE and design marks, which have been registered without disclaimer of, or a Section 2(f) claim to, PENNSTATE for similar services. In particular, Reg. No. 1870005 is for “medical transportation services by helicopter,” Reg. No. 1732445 is for “emergency medical transportation services,” and Reg. No. 5393863 is for educational services in the health and medical fields. These registrations are probative to demonstrate the USPTO considers the unitary term as pointing to Applicant and not as a geographical place. The latter registration includes an identical “lion” design, reinforcing the finding that the term PENNSTATE will be perceived by relevant consumers as identifying Applicant, whose mascot is the “Nittany Lion.” *See, e.g.*, Wikipedia entry for Pennsylvania State University, November 22, 2019 Response to Office Action, TSDR 5. Notably, Reg. No. 5393863,



Applicant’s registration for , issued February 6, 2018 for, inter alia, “educational services, namely, . . . providing public lectures and workshops, seminars and conferences in the fields of the arts, agriculture, architecture, business,

communications, economic development, education, energy, engineering, **health and medicine**, humanities, information sciences and technology, liberal arts, math, social science, natural resources, natural science, writing and speaking, and community service. . . .” (emphasis added).

The third-party website references are at best equivocal. The overwhelming majority of references located by Applicant’s Google search use “PENN STATE” to refer to Applicant. We also find it significant that there are no articles, search results, or social media pages of record that show “PENN” or “PENN.” being used as an abbreviation for Pennsylvania. Indeed, the online article “31 Things People From Pennsylvania Have To Explain To Out-Of-Towners” admonishes: “It’s Just PA - Pennsylvania is one of few states in which locals refer to their home simply by its abbreviation. The word ‘pee-ayy’ is more often than not heard in place of the full name.” June 12, 2020 Request for Reconsideration, TSDR 44.

For the above reasons, we find the Examining Attorney has failed to establish that PENNSTATE is the name of a place known generally to the relevant public. *See In re Broken Arrow Beef & Provision, LLC*, 129 USPQ2d 1431, 1433 (TTAB 2019) (finding insufficient evidence to establish that the letters “BA” in the mark BA BEEF was the name of a place known generally to the beef-purchasing public in the United States); *Newbridge Cutlery Co.*, 113 USPQ2d at 1451 (reversing Board’s finding that NEWBRIDGE HOME was primarily geographically descriptive for goods made in Newbridge, Ireland because of lack of substantial evidence that Newbridge is the

name of a place generally known to the public, which made it unnecessary to “separately consider whether a goods/place association exists”).

The primary significance of PENNSTATE is to refer to Applicant. *In re Pebble Beach Co.*, 19 USPQ2d 1687, 1688 (TTAB 1991) (primary significance of 17 MILE DRIVE is to refer to applicant; “The present case is similar to the situation of privately owned amusement parks or shopping centers or colleges, whose locations may be well known and whose marks may even appear on maps to indicate the location where their goods are sold or their services are rendered. Despite the fact that an amusement park, for example, occupies a specific physical location, and it renders services and sells goods under the name of the amusement park at that location, the park’s name is not a geographic term.”); *Univ. Book Store v. Bd. of Regents of the Univ. of Wis. Sys.*, 33 USPQ2d 1385, 1402 (TTAB 1994) (WISCONSIN BADGERS not primarily geographically descriptive for various items of apparel sold by the University of Wisconsin Board of Regents); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (primary significance of WESTPOINT is as the name of the United States Military Academy rather than the town of West Point, New York).

As the Board advised in *Broken Arrow*, “[w]hen it is not clear on its face that the primary significance of the mark is that of a geographic location, the record must include substantial evidence to support a conclusion that the mark identifies a place ‘known generally to the relevant American public.’” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1210.02(b) (Oct. 2018) (quoting *Newbridge Cutlery*, 113 USPQ2d at 1450). The record does not support a finding that a

significant portion of health and wellness consumers throughout the United States would understand that PENNSTATE identifies “a place known generally to the relevant American public.”¹¹ *Newbridge Cutlery*, 113 USPQ2d at 1450. The Examining Attorney has thus failed to establish the threshold element of geographic descriptiveness.¹²

Decision: The refusals to register are reversed.

¹¹ To the extent that the inclusion of “STATE” raises a doubt on the question of whether PENNSTATE is primarily geographically descriptive, we resolve such doubt, as we must, in favor of Applicant. *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451, 1455 (TTAB 1994) (reversing refusal to register HARVEYS BRISTOL CREAM absent disclaimer of allegedly geographical term “Bristol Cream” for “bakery goods, namely cakes,” stating, “To the extent that any evidence of record raises a doubt about our conclusion here, we elect to resolve that doubt in favor of applicant. Then, when the mark is published, any person who has a legitimate interest in the use of the geographic name claimed by applicant may file an opposition.”). *See also* cases and treatises cited therein in support of this proposition.

¹² As a result, we need not and do not reach the other elements. *Newbridge Cutlery*, 113 USPQ2d at 1451; *In re Trans Continental Records, Inc.*, 62 USPQ2d 1541, 1544 (TTAB 2002) (O-TOWN not primarily geographically descriptive even though Examining Attorney submitted evidence of term being used as nickname).